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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,206	12/27/2000	Akira Ohmura	108231	5375

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

SRIVASTAVA, VIVEK

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/748,206	Applicant(s) OHMURA ET AL.	
	Examiner Vivek Srivastava	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 and 44-52 is/are pending in the application.
 4a) Of the above claim(s) 1-35 and 48-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-39 and 44-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

Applicant argues "Thus, the controller described by Okada does not control the recording circuit such that the recording circuit does not execute the recording process to the digital image data, or control the second receiver such that the second receiver does not execute the receiving process to the digital image data while executing recording process to the visual broadcast program. Furthermore, the playback of the still image and the playback of the visual broadcast program are not started by an operation of one of the plurality of manual operation members, as recited in claims 45 and 46".

The Examiner respectfully disagrees. Okada discloses the user's request for recording is directed to controller 1902 which controls recording of the selected signal (see col. 17 lines 17 – 42). Thus Okada discloses the recording circuit does not execute the recording process to the digital image data, since the recording of the broadcasting program is performed. As a result, the Applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36 – 38 and 44 – 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada et al (US 6,266,483).

Regarding claims 36 and 44 - 46 Okada discloses a DVD-RAM image recording medium for use in an image recorder for recording television broadcast programs and still pictures from a digital camera (see col 6 lines 43 – 52).

Okada discloses a first receiver (digital tuner 1905 – see col 16 lines 7 - 16) which receives broadcasted programs via satellite and a second receiver (decoder 1908 – see col 16 lines 7 - 16) which receives images from a still camera (see col 15 lines 32 – 37, see col 6 lines 43 – 52). It is noted that since broadcast programs and still images are recorded on the DVD, necessarily Okada discloses a “storage capable of storing both the data of visual broadcast program and digital image data” and a “recording circuit capable of recording both the data of visual broadcast program and the digital image data into storage”.

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Okada further discloses a user can request to record a broadcast program from the digital tuner (see col 17 lines 15 – 20). It is noted that based on the user request, system controller 1902 (see fig. 19) controls the recording circuit to record the broadcast program in lieu of the image data (see col. 17 lines 17 – 42) and thus discloses the claimed *“a controller that controls one of the recording circuit such that the recording circuit does not execute the recording process to the digital image data, and the second receiver such that the second receiver does not execute the receiving process to the digital image data while executing recording process to the visual broadcast program”*. It is noted that the claim language at least one of requires at least one to meet the claim limitation, thus Okada discloses the claimed *“the recording circuit does not execute the recording process to the digital image data....”*.

Okada further discloses the claimed *“a manually operable controller that controls the playback both on the basis of the data of visual broadcast program and on the basis of the digital still image data”* (see col 17 lines 15 – 20). It is noted that basis is determined by the user, who determines by requesting (through a manual operation) which data to record or playback based on the user's preference.

Okada still further discloses the user interface 1901 accepts commands from a user for transmission to the system controller 1902 for selecting the appropriate modules for playing back the information requested (see col. 18 lines 11 – 21). Okaka also discloses the user manually selects the desired information to be played back, and according, the appropriate decoder is selected for

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playback (see col. 19 lines 1 – 15). Thus the decoders, the “plurality of operation members”, are selected by manual operations, wherein playback of the visual broadcast program are started by an operation of one of the decoders.

Claim 37 is met by the above.

Regarding claim 38, Okada discloses a user request or selects the data to be recorded (see col 17 lines 15 – 20). Necessarily, Okada discloses the claimed “wherein the controller is designed to control the recording circuit to postpone the recording of the digital image data until the recording of the visual program is closed” as requested, selected and preferred by the user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 6,266,483).

Regarding claim 47, Okada fails to disclose a second receiver with a memory slot into which a removable memory coming from the digital still camera is capable of being inserted.

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Official Notice is taken it would have been well known providing a removable memory from camera for insertion into an image recorder would have been well known for processing and displaying an image. For example, in the computer art, it would have been well known to have a PC or laptop with an card insertion slot for inserting a memory card from a camera. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada to include the claimed limitation for the benefit of processing and displaying an image on larger screen.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 6,266,483) in view of Browne (WO 92/22983).

Regarding claim 39, However, Okada fails to disclose simultaneous recording of image data with data of the visual broadcast program.

In analogous art, Browne teaches a storage 104c provides simultaneous recording of programs from a multiple of sources (see Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada to include the claimed storage medium to enable simultaneous recording of data from a plurality of sources.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shindler et al (US 5,867,223) – Home entertainment system

Maurinus et al (US 5,606,365) – Interactive camera for network processing

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (571) 272-7304. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272 – 7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs
3/14/06



VIVEK SRIVASTAVA
PRIMARY EXAMINER